

Application No. 09/980,158
Amendment dated August 30, 2004
Reply to the Office Action of June 10, 2004

REMARKS

Applicant has amended claims 1, 3, 4, 5, and 13 to further clarify inventive aspects of the invention. In the Office Action dated June 10, 2004, the Examiner rejected claims 1, 3-20 under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. Patent No. 6,473,892) in view of Ferrel et al. (U.S. Patent No. 5,860,073) and in further view of Smith et al. (U.S. Patent No. 6,052,693). The Examiner further rejected dependent claims 2 and 21 under 35 U.S.C. 103(a) as being unpatentable over Porter, in view of Ferrel, and in view of Smith, and further in view of Atkins (U.S. Patent No. 5,875,437).

The undersigned has reviewed the June 10, 2004, Office Action and respectfully traverses all rejections for the reasons set forth herein. No new matter has been added. The undersigned respectfully requests that all pending claims, as amended, be allowed.

A. Overview

The present invention is directed to systems and methods for the assembly of documents that greatly simplify the updating of information that is to be included in the documents. In the present invention, information is contained in unique objects. The objects can be accessed to create multiple and diverse documents. If the information needs to be updated, only the particular object containing the information to be changed needs to be modified. Because all of the objects contained in an object library are unique, any change to a piece of information controlled by a particular object need only be made once and the change will be reflected in any document that is generated to include that information. (p. 14 lines 10-18).

The present invention accomplished this by using a plurality of grammar lines to guide assembly of a document. Conditions within the grammar lines are tested and if the conditions are true, an instruction associated with the grammar line is executed. The instruction may append an object to a sequence of information that is used to create the document, or move to another grammar line. Moving between grammar lines is accomplished by the use of grammar tags (p. 4 lines 20-25).

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B. 35 U.S.C. 103(a)

The Examiner has rejected claims 1-37 under 35 U.S.C. 103(a) as being unpatentable over Porter, in view of Ferrel, and further in view of Smith. For the reasons set forth below, Applicant respectfully traverses the rejection and requests allowance of the pending claims.

Porter is directed to a document assembly system that automatically determines which documents are needed for a particular transaction, automatically determines which paragraphs should be included in each document and automatically generates the text of each document (col. 6 lines 51-60) Porter compiles source code created by programmers to create object code. The object code, contained in form objects, text object, and macro objects is interpreted as Porter produces a document. (col. 7 lines 15-25)

According to the process Porter describes, if a particular document is unsuitable for any reason, complex programming steps must be taken to modify the document. According to Porter, in order to modify a document, a programmer must make changes to the source code for the particular document to be modified. The new source code must then be recompiled into object code before the modified object code can be executed to generate a new document and determine if the new document is suitable for a task (col. 7 lines 54-65). The process of Porter is not conducive for most bankers to assemble custom documents, since most banker are not equipped to write source code and compile it into object code.

Ferrel is directed to methods of formatting information. In particular, Ferrel is directed to the application of formatting information, such as fonts and tabs to various regions on a page (col. 3 lines 7-15) Ferrel specifically does not include any text or other information in the style sheet (col. 3 lines 15-17). In Ferrel, a user must supply all text in a document. Ferrel then describes the use of tags to indicate that a style corresponding to the tag be applied to all of the text below the tag until another subsequent tag is reached. At the subsequent tag, a style corresponding with the subsequent tag will then be applied to the text following it, and so on throughout the document.

Smith is directed to a system for facilitating flow of documents in the police force of the United Kingdom that can be used in conjunction with investigations of major crimes. Smith

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describes both external text extraction and internal text extraction in order to create an index of information useful to an investigation. During the course of the indexing process, ambiguity in an extracted text is resolved with rules that include: analysis that span more words are preferred over analysis that span fewer and analysis that produce bigger single units are preferred over those producing smaller units. The indexing processes take as input Grammar Rules and Word Lists to assist in interpreting text (col. 16 lines 24-39). Grammar Rules are used in Smith to instruct a word parser how to label words and phrases recognized from an input sentence and to assist in assigning an attribute to words contained in an input text. Smith also discusses the use of common Boolean equations when testing for true or false conditions. As used in Smith, the Boolean equations are disparate from the Grammar Rules and Word Lists of Smith in the sense that Smith does not describe Grammar Rules that contain Boolean equations..

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, in order for the Examiner to establish a case of obviousness, he must (a) demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention, and (b) show a motivation to modify or combine the references. The Examiner has done neither.

As discussed above, Porter describes systems that require a programmer to access and write source code in order to change a document. In Porter the mention of "objects" refers to the source code that has been written by a programmer and then compiled (or recompiled) into

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object code. Porter does not describe or suggest all of the claimed limitations, either alone or in view of Ferrel or in view of Smith.

The present invention provides for a system with grammar lines that contain all of the instructions needed to create the document. Each of the grammar lines included a condition and an instruction. Data descriptive of financial transactions is received and used to test the conditions in the grammar lines. If the condition is true, then the associated instruction is executed. The instructions either move to another grammar line, or insert an object body into the document being created.

As claimed in the amended independent claims 1 and 13, the present invention teaches a simple process for modifying a document. Documents are made up of various object bodies. If a document needs to be modified, a user only needs to change an appropriate object body. All grammar sequences that reference that object body will consequently be changed. Unlike Porter, the present invention does not require a programmer to write source code in order to modify a document. Additionally, unlike Porter, the present invention provides an elegant solution that does not require modified source code to be recompiled in order to effect the modification to the document. Porter simply does not describe or suggest the concepts taught by the present invention, which allow for automatic assembly of easily customizable documents.

Ferrel and Smith do not make up for Porter's shortcomings. As indicated above, Ferrel describes a text formatting method and Smith describes methods for organizing information in response to a crime investigation. Neither one describes any of the aspects just discussed in regards to Porter. Even if Ferrel or Smith did describe any of these unique aspects, the Examiner has not provided any motivation to combine Ferrel with Smith.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts." In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not shown any of these sources in the Office Action of June 10, 2004. Although, in his rejections of claims 1, 4-20 the Examiner stated that "it would have been obvious to one with ordinary skill in the art [i.e. to combine Porter and Ferrel or Smith]," he did

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so without offering any evidentiary support for his conclusion. Such conclusory statements do not constitute the requisite evidence upon which a Section 103 rejection may rest. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Thus, the Examiner cannot base a rejection purely on what he deems would be obvious to “one with ordinary skill in the art”; rather he must offer evidentiary support for what in fact is known to skilled artisans before making a conclusion as to what would be obvious to a skilled artisan.

The Examiner again fell short of meeting the requirements of the case law by concluding: in his rejection of claims 2 and 21 that Atkins describes a confirmation of a financial transaction that includes economic terms. (Office Action of June 10, 2004, p. 12).

Atkins is directed to methods and systems for personal financial analysis, planning and management. Atkins describes a central operating account for performing various functions related to personal finance. In regards to the Examiner’s suggestion that Atkins describes a financial function to verify and confirm transactions, Atkins merely describes verification of a customer prior to a transaction. Atkins also describes customer verification of a transaction prior to the transaction being approved. Column 60 lines 13-16 specifically describe one example where Atkins describes “verification of whether the transaction will be permitted or denied (emphasis added). Atkins does not suggest or describe any system for automatically generating a document descriptive of one or more transactions conducted by a financial trading system, as claimed in the amended claims.

Further, Atkins mere mention of a Word Processing function is not sufficient to hold obvious an automated document assembly invention, simply because the Word Processor inherently could conceivably be used to generate a document describing a financial transaction. “[I]nherency . . . and [] obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” In re Spormann, 363 F.2d 444, 448 (C.C.P.A. 1966). Accordingly, the Examiner’s Section 103 rejection cannot stand based on his plain statements of what is inherent in Porter and Smith or Atkins.

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Thus, Applicant respectfully submits that it would not have been obvious to combine Porter with Atkins and that even if Porter and Atkins were combined, their sum product would not contain the unique limitations of claims 2 and 21.

Claims 2-12 depend from independent claim 1, and claims 14-21 depend from independent claim 13, and define further features and structure of the methods and systems. As such, these dependent claims are patentable for the reasons noted above with respect to claims 1 and 13, as well as for the additional features recited therein. Accordingly, notice to the effect that claims 1-21 are in condition for immediate allowance is respectfully requested.

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CONCLUSION


For the reasons set forth above, allowance of this application is courteously urged. If there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned at (212) 878-8476 in order for the undersigned to arrange for an interview with the Examiner.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

Please also note our new address listed below. Please send all future correspondence to this new address.

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Respectfully submitted,


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